

## REMARKS

Claims 1-8 are pending.

Claims 1-8 are rejected.

### **35 USC 103(a)**

Claims 1-8 are rejected under 35 USC 103(a) as being unpatentable over Cox, US 4,882,077 in view of Amende, DE 2,054,649.

Cox discloses metalworking fluids comprising a paraffin oil and an emulsifier. Examiner agrees that Cox does not disclose the compounds of claims 1-5.

In particular, Cox teaches no amide structures of succinic acid, which is a distinctive structural embodiment. Cox teaches only diesters from adipic acid and other dibasic acids (Col. 4, lines 11-13) but no amides

However, examiner states that Amende discloses the preparation of a compound by the reaction of an acrylic acid ester and alkylamines such as laurylamine, stearylamine, and oleyl amine, followed by further reaction with maleic anhydride. On page 6 Amende discloses that succinic anhydride can be used in place of maleic anhydride. Amende discloses that the compound is useful as an emulsifier.

Thus according to the examiner it would be obvious to use the compound of Amende in the metalworking fluid of Cox as Amende teaches that the compound acts as an emulsifier.

Cox teaches the use of emulsifiers in metalworking fluids. Cox teaches that any oil-in-water emulsifier may be used but it is desirable that the emulsifier be either anionic or nonionic in nature. See col. 4, lines 20-25. The preferred nonionic emulsifier is believed to be a linear alcohol capped with a fatty acid. See col. 4, lines 42-44. The preferred anionic emulsifier is an ethoxylated fatty acid type emulsifier. See col. 4, line 45-46.

Amende describes the addition of primary amines to acrylic acid esters and the subsequent reaction with succinic anhydride and directs the product formed to textile adjuvants. This utility is unrelated with the use of the claimed compositions as lubricant compositions.

Amende and Cox could not be considered in any way analogous art. Cox deals with metal working fluids and Amende is concerned with textile adjuvants. The two systems are not at all comparable.

The examiner cites as the motivation to combine these two pieces of virtually unrelated art to the fact that Amende suggests the use of his reaction product as an emulsifier and Cox uses emulsifiers in his metalworking systems.

As examiner is no doubt aware, there are many types of emulsifiers. Cox suggests only two types, anionic or nonionic and gives several examples of such types. These types of emulsifier do not contain the structural limitations suggested by Allende or the presently claimed formula (1). Thus there is absolutely no reason why one skilled in the art would look to Allende, a reference dealing with nonanalogous art for emulsifiers which contain structural attributes not remotely suggested by Cox.

It is irrelevant that the compounds of Allende are useful as emulgators. This property is known for an almost unlimited number of compounds of different structure.

Furthermore, even if there were a reason to combine these two references (and the applicants avers there is no motivation, teaching or suggestion to combine), the combination of structures of formula (I) with a base oil of lubricating viscosity give advantages that could not have been predicted based on either of the cited references.

The applicants refer the examiner to the results given on page 21. These tests show corrosion protection properties according to ASTM D 665 of a formulated oil mixed with seawater and compounds of formula (I).

The combination of compounds of formula (I) with a base oil of lubricating viscosity clearly shows improved corrosion protection. Each test is carried out in duplicate. The base oil without the compounds of formula (I) shows a heavy corrosion rating of 3 (worst possible rating). When the base oil is combined with compounds of formula (I) corrosion ratings of 0 or 1 are seen. This is certainly surprising and could not have been predicted based on the cited references.

Thus because there is no common link between the primary reference, Cox and secondary reference Allende, there is no motivation at all to combine.

Secondly, even if there were some motivation (and applicants aver there is none), the base oil when combined with compounds of formula (I) give unobvious improved corrosion ratings.

**Claims 1-6 and 8 are rejected under 35 USC 103(a) as being unpatentable over Kubo, US 5,362,375 in view of Amende.**

The applicants believe this rejection to lack merit for similar reasons as explained above in the Cox rejection.

Firstly, Kubo makes one reference to the use of emulsifiers in his oil compositions. There is no suggestion or teaching of what emulsifiers might be useful to him. See col. 4, line 66.

According to the examiner, Amende supplies the missing claim limitation for formula (I) because Amende refers to his reaction products as emulsifiers.

While the examiner is of the opinion that one skilled in the art would look to Amende, a reference which deals with an unrelated technology area (textile aduants), and take the specific emulsifier used in this unrelated system and combine with the Kubo Oil systems, the applicants believe this to be a clear case of hindsight analysis by the examiner. Neither reference deals with related technology. Each mention the term "emulsifier" but there is no particular reason why one would select the emulsifier defined in Amende and combine with oil system of Kubo. There are many other emulsifiers which might have more readily come to mind such as emulsifiers which are known for use in oil systems.

As explained above there are many types of emulsifiers, and one would need more than just the identifier of "emulsifier" to look to Amende for combining with the oils of Kubo.

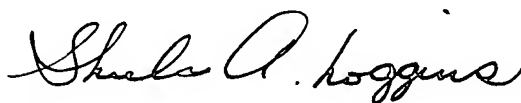
Furthermore, as explained above even if it made sense to combine these two unrelated references, the advantages of the presently claimed combinations are certainly unobvious and not suggested or taught by either cited reference. Unobvious advantages are indicators of unobviousness.

Reconsideration and withdrawal of the rejection of claims 1-8 is respectfully solicited in light of the remarks *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 1-8 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



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